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Paper No. 27
AFD

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Excelnet(Guernsey) Limited

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Serial No. 75/048,668

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Jane F. Collen of Collen Law Associates P.C. for Excelnet (Guernsey) Limited.

Brendan Regan, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

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Before Quinn, Walters and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

In this appeal, Excelnet (Guernsey) Limited (applicant) seeks to register the mark EXCELNET and design for services it now identifies as "insurance brokerage services excluding mortgage brokerage services provided exclusively to mortgage lending institutions."[1] While this

[1] Application Serial No. 75/048,668 filed January 25, 1996, based on a bona fide intention to use the mark in commerce and a claim of priority based on a foreign application. Subsequently, applicant submitted United Kingdom Registration No. 2,029,841.

new identification was submitted with applicant's appeal brief, the examining attorney has discussed the new identification of services and has not objected to it. Therefore, the Board will consider this identification of services in determining whether there is a likelihood of confusion.

The examining attorney has refused to register applicant's mark because of a prior registration for the mark EXCEL for "insurance administration, consultation and mortgage underwriting services provided exclusively to mortgage lending institutions"[2] under Section 2(d) of the Trademark Act.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs. An oral hearing was not requested.

After carefully considering the record, the examining attorney's refusal to register applicant's mark EXCELNET, because it is likely to cause confusion with U.S. Registration No. 1,775,462, is affirmed.[3]

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[2] Registration No. 1,775,462, dated June 8, 1993. Section 8 affidavit filed November 5, 1998.

[3] Prior to filing its appeal brief, the applicant had amended its identification of services to read "insurance brokerage." See Amendment to Trademark Application and Request for Reconsideration dated February 22, 1999. The examining attorney subsequently accepted this identification of services. See Office Action dated July 7, 1999. Obviously, this identification

Our primary reviewing court's predecessor, the Court of Custom and Patent Appeals, has set out a non-exclusive list of thirteen factors that should be considered in determining whether there is a likelihood of confusion. In re E.I. du Pont De Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). These factors include the similarity or dissimilarity in the marks and the goods, the channels of trade, buying conditions, fame of the mark, use of similar marks on similar goods, actual confusion, concurrent use, the variety of goods on which the mark is used, and the presence of a consent agreement. Id.

Likelihood of confusion is decided upon the facts of each case. In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ 1531, 1533 (Fed. Cir. 1997); In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ 1687, 1688 (Fed. Cir. 1992). The various factors may play more or less weighty roles in any particular determination of likelihood of confusion. Shell Oil, 992 F.2d at 1206, 26 USPQ2d 1688; du Pont, 476 F.2d at 1361, 177 USPQ at 567.

In this case, applicant argues that it "demonstrated that the Applicant's mark and the cited mark are different in all these factors [sound, appearance, meaning and

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of services, which is broader than the services identified in applicant's appeal brief, would not make confusion less likely.

commercial impression] and that no confusion would be likely." Applicant's Appeal Brief, p. 2. Its arguments are that its mark is visually different from the registered mark with eight letters instead of registrant's five, it is pronounced differently, and that its mark has technology-oriented overtones.

Obviously, marks do not have to be identical to be confusingly similar. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816-17 (Fed. Cir. 1987) (Marks not identical but strikingly similar). Here, applicant has simply taken registrant's entire mark and added the term "net" at the end and a design. It is well settled that marks must be viewed in their entireties, Shell Oil, 992 F.2d at 1206, 26 USPQ2d 1688, and that the addition of a term to a registered mark may obviate the likelihood of confusion. In re Electrolyte Laboratories, 929 F.2d 645, 16 USPQ2d 1239 (Fed. Cir. 1990). However, registrant's and applicant's mark are similar in appearance, sound, meaning, and commercial impression despite the addition of the term "net" and the design in applicant's mark.

First, the registrant's entire mark has been incorporated into applicant's mark. It is the dominant part of applicant's mark. In a similar case, the Federal

Circuit held that the addition of the words "The" and "Cafe" and a design to registrant's DELTA mark still resulted in a likelihood of confusion. Dixie Restaurants, 41 USPQ2d at 1534 (more weight given to common dominant word DELTA). See also Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977)(CALIFORNIA CONCEPT and design likely to be confused with CONCEPT for hair care products).

Also, applicant points out that its mark is in special form. While applicant's mark is in special form, the registrant's mark is in typed form. An argument concerning different type styles is not viable when, as in this case, the registration is in typed form and not limited to any special form. Squirtco v. Tomy Corp., 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983).

Second, applicant's argument that the marks create different commercial impressions is difficult to accept. Certainly, it is improper to dissect a mark and marks must be considered in their entireties. Shell Oil, 992 F.2d at 1206, 26 USPQ2d at 1688. However, more or less weight may be given to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, the term EXCEL would likely be considered the dominant feature. The addition of the

ending NET only reinforces the connection with the registration. As applicant itself argues, its mark has technology-related overtones that would suggest that the services under the EXCELNET mark are an updated version of registrant's services. In addition, the small design element in applicant's mark does not eliminate the confusion, which would otherwise be likely. Giant Foods, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983)(Differences between GIANT HAMBURGERS and design and GIANT and GIANT FOODS and designs not sufficient to overcome the likelihood of confusion); Dixie Restaurants, 41 USPQ2d at 1534 (Design element of ordinary geometric shape does not offer sufficient distinctiveness to create a different commercial impression). The simple design element in applicant's mark almost blends into the stylized letters and it does not create a different commercial impression.

Third, applicant argues that its mark has a different meaning because its mark has "very strong technology-related overtones, ones which are immediately perceptible to the average consumer of these products and services." Applicant's Amendment dated December 30, 1999, p. 3. Even if applicant's argument is accepted, the "technology-related overtones" that applicant refers to would simply be

a reference to the fact that "net" is often a short form of the word "Internet." Data Concepts Inc. Digital Consulting Inc., 150 F.3d 620, 47 USPQ2d 1672, 1675 n.1 (6th Cir. 1998) ("[T]he practice of "surfing the Net" gives rise to the prospect that Data Concepts' use of Digital Consulting's registered mark as its Internet domain name would cause confusion"); Intermatic Inc. v. Toeppen, 947 F. Supp. 1227, 40 USPQ2d 1412, 1414 (N.D. Ill. 1996), approved, 41 USPQ2d 1223 (N.D. Ill. 1996) ("An estimated 30 million people worldwide use the Internet with 100 million predicted to be on the "net" in a matter of years". See also Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1699 (Fed. Cir. 1992) (CENTURY 21 for real estate brokerage services also the source of CENTURYNET for leasing time to a computer data base for mortgage loan information). Adding the term "net" to the registered mark EXCEL would likely create the impression that the services provided under the registered mark are now performed in a more high technology manner such as on the Internet. If that were true, potential customers would simply believe that applicant's services are a more modern version of the registrant's services that are performed in a high technology format.

Fourth, the sound of the two marks is similar. While there is an obvious additional syllable at the end of applicant's mark, it does use the entire registered mark with just a "net" added at the end. While applicant counts letters and reaches a different conclusion, its calculus cannot obscure the fact that the EXCELNET is the registered mark EXCEL with NET at the end. Dixie Restaurant, 41 USPQ2d at 1533 (THE DELTA CAFE similar in sound to DELTA).

Finally, the only other issue is whether the services are sufficiently related. Applicant seeks to register its mark for services that it now identifies as "insurance brokerage services, excluding mortgage underwriting services provided exclusively to mortgage lending institutions." The services in the cited registration are "insurance administration, consultation and mortgage underwriting services provided exclusively to mortgage lending institutions." Applicant's insurance brokerage services and registrant's insurance administration services are closely related. As the examining attorney points out, it would be unusual for an insurance broker not to also provide insurance administration services. Examining Attorney's Appeal Brief at 8. In addition, the examining attorney relies on the Century 21 case. There, real estate broker services and insurance brokerage services were

provided by the same entity and the marks used on the parties' insurance services were found to be confusingly similar. Century 21, 23 USPQ2d at 1699.

Applicant has sought to eliminate the likelihood of confusion by limiting its services so that they do not include mortgage underwriting services provided exclusively to mortgage lending institutions. This identification of services does not eliminate the likelihood of confusion because applicant's services could still be provided to mortgage lending institutions so long as it did not offer the services exclusively to mortgage lending institutions. For example, applicant's brokerage services could include insurance such as life, health, and casualty insurance for businesses. These services would be offered across the board to all types of businesses including mortgage lending institutions. When the same employees responsible for obtaining insurance administration services at mortgage lending institutions encountered applicant's mark for other business insurance, confusion would be likely. "Even if the overlap between applicant's and registrant's services is small, it is not de minimis in relation to registrant's customers because all its customers are potential customers of Applicant." Shell Oil, 26 USPQ2d at 1690.

Even if applicant's services are never offered to mortgage lending institutions, confusion would still be likely. Employees of mortgage lending institutions who are familiar with registrant's EXCEL insurance administration services would use the services of an insurance broker or agent to obtain their own personal insurance for their home, life or health. When they encountered the mark EXCELNET in connection with insurance brokerage services, they would likely believe that the source of the insurance brokerage services was the same as the EXCEL insurance administration services. The Federal Circuit has held that distributorship services in the field of automotive parts were related to service station oil change and lubrication services even though the distributorship services involved purchasing automotive parts from manufacturers and then distributing them to retailers. Shell Oil, 26 USPQ2d at 1689-90. Similarly, purchasers of insurance administration services for mortgage lending institutions would likely be confused when they encountered a very similar mark for insurance brokerage services for their personal needs. Even sophisticated purchasers can be confused by very similar marks. Octocom Systems Inc. v. Houston Computer Services, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Decision: The refusal to register is affirmed.